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JFWIN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCESIn Re Applicant: Alan B. ShueySerial No. 10/029,087Confirmation No. 3407Filed: December 20, 2001Group Art Unit: 3677Examiner: Ruth C. RodriguezSupervisory Patent Examiner: J. J. SwannAssignee: Ductmate Industries, Inc.

Title of Invention:

Releasable Cable Grip

Attorney Docket No. 010071

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September 7, 2004

REPLY BRIEF

This is a Reply Brief in response to the Examiner's Answer dated July 7, 2004.

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." The issue is whether or not Pasbrig has suggested the desirability of the modification of Facey.

The Examiner is arguing that the following teachings by Pasbrig suggest the desirability of modifying Facey:

- (i) "the release lever prevents canting of the wedge means"

- (ii) “[the release lever] allows guidance of the wedge means with precision and transmits the force employed for unclamping directly to the wedge means.

Examiner’s Answer p. 7 ls. 14-7.

In order for a person of ordinary skill in the art to find the above reasons as motivating factors to modify Facey, they would have to find that Facey has those problems. Facey would have to have a canting problem. The unclamping force employed by Facey would have to be applied indirectly to the wedge means.

The Examiner has admitted that the unclamping force in Facey is applied directly to the wedge means. “The Examiner agrees with the appellants that the tool directly engages the wedge means.” Examiner’s Answer p. 9 ls. 5-6. Therefore, a person of ordinary skill in the art would not find that Pasbrig’s teaching of “the release lever allows guidance of the wedge means with precision and transmits the force employed for unclamping directly to the wedge means” as motivation to modify Facey because Facey does not have the problem.

Appellant notes that this is the first time that the Examiner has suggested that prevention of canting as a reason for the modification. However, Facey does not have a canting problem. A person of ordinary skill in the art would look at Facey and see that not only does Facey apply force directly to the wedge means but it applies the unclamping force in exactly the opposite direction of the clamping force. The hole in which the tool is inserted is just large enough to permit the tool to enter and directly contact the wedge means and only allows the unclamping force to be applied in the direct opposite direction of the clamping force.

Facey does not have a slot. Facey does not have a release lever. Facey's wedge means is square. The track for the wedge means is square. There is no chance for canting to occur in Facey. Therefore a person of ordinary skill in the art would not find that Pasbrig's teaching of "prevention of canting" as motivation to modify Facey because Facey does not have the problem.

The only way canting becomes an issue is if you put slots in Facey and use a release lever such as applicants claimed invention. This shows the Examiner is using the Applicant's claimed invention as a blue print to combine the prior art. Pasbrig's teaching of preventing canting is taught with respect to art that uses slots and release levers that apply force indirectly. It is not teaching any advantage over Facey.

The prior art does not provide motivation or suggest the desirability of modifying Facey with Pasbrig.

The Examiner has also suggests that convenience is a motivating factor. None of the prior art suggests convenience. In Appellant's brief, Appellant argued that security should be weighed to negate the issue of convenience. Applicant agrees with Examiner that there is no risk of accidental release. The Examiner stated, "there are not security issues being raised by Facey that will render Pasbrig's release lever as unsafe." The Appellant never raised safety as an issue and agrees with Examiner that it is not unsafe. Appellant's invention is in fact safer than the prior art.

In determining whether convenience is a motivating factor "the benefit, both lost and gained, should be weighted against one another." Examiners Answer p. 11 ls. 2-3 (citing Winner International Royalty Corp v Wang). The issue is whether or not the Examiner has shown that the Examiner's suggested benefit out weights what is lost to the

extent that it would make it obvious to a person of ordinary skill in the art to modify Facey by Pasbrig.

The Examiners argued benefits of modifying Facey by Pasbrig are as follows:

- (i) “avoiding the constant use of a separate tool that could become lost”
- (ii) “providing a double safe mechanism”; and
- (iii) “release levers allows a more controlled use”.

Examiners Answer p. 11 ls. 9-27

Appellant agrees that the need for a separate tool as required by Facey is a benefit to the combination.

Providing a double safe mechanism is not motivation to modify Facey. Facey does not have a risk of failure of the release lever. The Examiner is listing a benefit that the tool is a backup release if the release lever fails. This is not motivation to modify Facey to use a release lever. This is actually a factor weighing against the combination. Additionally, the Examiner states it will prevent the risk of losing the tool because it can be stored in a safe place. Something that is used infrequently is more likely to be misplaced than something that is frequently used.

The release lever does not allow a more controlled use.

What is lost by the combination is the following:

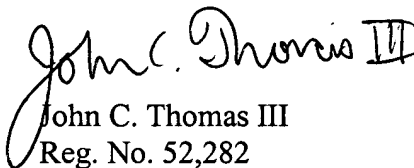
- (i) only the person with the tool can adjust;
- (ii) cost of manufacturing is more expensive because of cutting the slot and the additional integral release lever;
- (iii) risk of failure of the device, i.e. the lever breaking off is greater; and
- (iv) introducing a risk of canting into the mechanism.

The above list of what is lost outweighs the examiner's sole benefit of avoiding the constant use of a separate tool that could become lost for purposes of obviousness. Even if all of the Examiners benefits are consider it does not outweigh the above list of what is lost to make the modification obvious.

The Examiner admits that Facey's use of a separate tool is a preferred embodiment for the release of the wedge means. Examiners Answer p. 8 ls. 2-3. Any use of a release lever runs counter to Facey's explicit recital of a preference for use of a separate tool. Facey teaches away from using a release lever.

There is no suggestion to modify Facey with Pasbrig.

Respectfully submitted,


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